UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
HESSELTINE, RYAN J

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Office Action Summary	09/517,163		HINOUE ET AL.
	Examiner		Art Unit
	Ryan J Hesseltine		2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 January 2004_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-4 and 6-16_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4 and 6-16_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments on pages 8-9, filed January 27, 2004, with respect to the

rejection(s)of claim(s) 1 under 35 U.S.C. 103(a) have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new

ground(s) of rejection is made in view of Lambert (USPN 6,193,153, previously cited).

2.   Applicant's arguments on pages 9-10, filed January 27, 2004, with respect to claims 7 and

14 have been fully considered but they are not persuasive.

3.   Page 9, last paragraph states with respect to Angelo as applied to claim 7, "Applicants

submit that no evidence has been provided to suggest that because there is a match in plain text

that there would be a match in fingerprints." The examiner respectfully disagrees. Angelo

discloses an access control method for a computer system wherein a control means controls the

operation of a power source of the information processing apparatus (column 8, line 7-34) when

there is a match in plain text passwords, which may be generated from a scanned fingerprint

(column 7, line 26-33). The examiner is not attempting to equate a plain text password with a

fingerprint, but is saying that they are used equivalently. The fact that a plain text password is

used for authentication rather than a fingerprint image is immaterial to the fact that Angelo

discloses the claimed operation of a power source after authentication has taken place. In

addition, claim 1 (from which claim 7 depends) is silent on the specifics of the fingerprint

verification. Lastly, Angelo clearly discloses that the plain text password may be generated with

the aid of biometrics such as a scanned fingerprint, which attests to the uniqueness of the

password (column 7, line 26-33). While it is not explicitly disclosed, it is obvious that another

plain text password could be generated from another scanned fingerprint at the time of

authentication to be compared with the stored password (column 8, line 7-12).

4.   Page 10, last paragraph states, "With respect to claim 14, Applicants submit that Shieh

does not disclose an execution level of a designated menu area in addition to an execution level

associated with an authorized user, as recited in the claim." The examiner respectfully disagrees.

Shieh's Figure 2 clearly shows a fingerprint **area** 240 associated with the **execution level** of a

default **menu** 263 (column 5, line 10-18 and 30-32). Figures 4-6 show similar fingerprint areas

associated with various functions and/or menus and Figure 7 shows an example of a host of

different menus displayed on the touch screen device (column 7, line 44-column 8, line 7, line

15-21, 35-40). Lastly, Shieh discloses that a virtual pointing device may be created that is

unique to the recognized (authorized) user wherein a user file stores predefined customization

features (Figure 5; column 4, line 16-42).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lambert (USPN 6,193,153) in view of Fitzpatrick et al. (USPN 5,420,936, previously cited,

"Fitzpatrick") or in view of Fernando et al. (USPN 6,193,152, previously cited, "Fernando").

7.   Regarding claim 1, Lambert discloses an information processing apparatus comprising:

fingerprint verification (biometric comparison) means for verifying a fingerprint read from a

fingerprint reading surface (transparent numeric keypad; column 12, line 25-34; column 13, line

62-column 14, line 6, line 25-34) against previously stored fingerprints (database) of authorized

users (column 13, line 1-17), the information processing apparatus further comprising: display

means (transparent numeric keypad/touchpad) having a display surface with orthogonal

coordinates (X, Y, implicit) set thereon (Figure 4; column 13, line 62-column 14, line 6, line 25-

34, line 53-63); coordinate designating means (transparent numeric keypad/touchpad) for

designating coordinates related to fingerprint reading on the display surface (column 13, line 62-

column 14, line 6); secret number (password) acquiring means (numeric touchpad) for acquiring

a secret number based on said designated coordinates, said acquiring occurs concurrently with

said fingerprint reading on the display surface (column 14, line 25-34, line 53-column 15, line 6);

secret number identifying means for verifying (matching) the acquired secret number against a

previously stored secret number (column 14, line 58-60); and control means (operating system

such as Microsoft Windows or MacOS) for controlling an operation based on designated

coordinates (column 4, 58-63) and a result of the secret number verification (column 13, line 65-

column 14, line 6, line 56-63).

8.   Lambert does not explicitly disclose that the display surface is provided with orthogonal

coordinates set thereon and designating coordinates on the display surface related to the

fingerprint reading or the secret number acquiring. Fitzpatrick discloses a method and apparatus

for accessing touch screen desktop objects via fingerprint recognition including a multi-point,

touch-sensitive surface 70 which detects contact at given points (coordinates) provided with a

monitor 50 (column 4, line 3-26). Alternatively, Fernando discloses a modular signature and

data-capture system and point of transaction payment and reward system including secret

number (personal identification number-PIN) acquiring means virtual keypad (420) provided

over LCD 50 (Figure 3; column 11, line 28-35) including an analog-to-digital (A/D) interface

which converts the analog pen position to the high resolution x- and y-axis coordinates of touch

pad (50A), as is well known in the art (column 5, line 59-64). It would have been obvious to one

of ordinary skill in the art at the time the invention was made to obtain coordinates related to

fingerprint reading as taught by Fitzpatrick in order to provide a secure, user-friendly system

using touch screen technology to capture and recognize fingerprints (column 1, line 59-67)

and/or obtain coordinates related to a secret number (PIN) as well as fingerprints as taught by

Fernando in order to provide security beyond that associated with PIN identification since PINs

can easily be lost or compromised (column 1, line 52-57) and to provide a product and system

that can interface with a variety of input/output and other peripheral device such as a fingerprint

reader (column 2, line 7-22).

9.   Regarding claim 2, Lambert discloses that the display surface and the fingerprint reading

surface (transparent numeric keypad) are one and the same (column 13, line 62-column 14, line

6, line 25-34, line 53-63).

10.   Regarding claim 3, Fitzpatrick discloses that the fingerprint reading surface is formed on

the coordinate designating means (column 4, line 3-10).

11.   Regarding claim 4, Fitzpatrick discloses that the control means activates the fingerprint

verification means when specific coordinates are designated (column 4, line 16-26).

12.   Regarding claim 11, Fitzpatrick discloses that the information processing apparatus

further comprises: icon setting means for setting an icon associated with an application (column

4, line 10-14); and icon designation judging means for judging whether the set icon is designated

or not, based on designated coordinates (column 4, line 3-10), wherein when the icon is

designated and there is a match in fingerprint as a result of the fingerprint verification, the

control means reads out only data of a user having the matching fingerprint in an application

associated with the designated icon and causes the data to be displayed (column 4, line 14-26).

13.   Regarding claim 12, Fitzpatrick discloses that when an icon is designated and there is a

match in fingerprint as a result of the fingerprint verification, the control means initiates an

application associated with a user having the matching fingerprint among applications previously

set for the respective authorized users ("per-icon" access table 76, column 4, line 18-26).

14.   Regarding claim 13, Fitzpatrick discloses that the respective icons are associated with

files for the respective authorized users; and when an icon is designated and there is a match in

fingerprint as a result of the fingerprint verification, the control means opens only a file

(program/data) of a user having the matching fingerprint out of files associated with the

designated icon (column 4, line 18-26).

15.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert in view of

Fitzpatrick or Fernando as applied to claim 1 above, and further in view of Matsumura (USPN

5,493,621, previously cited). Lambert does not explicitly disclose that the fingerprint

verification means is activated when the secret numbers match each other. Matsumura discloses

a fingerprint identification system and method wherein the control means activates the

fingerprint verification means when an ID number or password matches each other (column 11,

line 44-50). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to activate the finger verification when the secret numbers match as taught

by Matsumura in order to permit high-speed matching of fingerprints by reducing the time it

takes to compare fingerprints since a user's fingerprint can be compared with a smaller subset of

prints (column 11, line 48-54).

16.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert in view of

Fitzpatrick or Fernando as applied to claim 1 above, and further in view of Angelo (USPN

5,887,131, previously cited). Lambert does not disclose operation of a power source when there

is a fingerprint match. Angelo discloses an access control method for a computer system

wherein a control means controls the operation of a power source of the information processing

apparatus (column 8, line 7-34) when there is a match in plain text passwords generated from a

scanned fingerprint (column 7, line 26-33). It would have been obvious to one of ordinary skill

in the art at the time the invention was made to operate a power source when there is a

fingerprint/password match as taught by Angelo in order to prevent repeated attempts to gain

unauthorized access to the system (column 3, line 10-20).

17.   Claims 8-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lambert in view of Fitzpatrick or Fernando as applied to claim 1 above, and further in view of

Shieh (USPN 5,874,948, cited on applicant's IDS).

18.   Regarding claim 8, Lambert does not disclose reading an operating condition associated

with each user. Shieh discloses when there is a match as a result of the verification of the read

fingerprint against the previously stored fingerprints, the control means reads out an operation

condition associated with an authorized user having the matching fingerprint from among

operation conditions previously set for the authorized users and sets the condition (column 4, line 28-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to read an operating condition associated with each user as taught by Shieh in order to allow users to customize their working environment (column 4, line 28-33).

19.   Regarding claim 9, Lambert does not expressly disclose that all fingers on both hands can be verified. Shieh discloses that the fingerprint verification means is capable of verifying fingerprints of all fingers of both hands (column 3, line 55-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to verify all fingers of both hands as taught by Shieh in order to associate commands with each identifying feature (column 5, line 10-18).

20.   Regarding claim 10, Lambert does not disclose associating a command with each finger of the user. Shieh discloses that when the fingerprints of the respective fingers match the previously stored ones, the control means reads out a command associated with each finger of the user having the matching fingerprints, from among commands previously registered for the respective fingers of the authorized user and executes the commands (figure 2; column 5, line 1-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to associate commands with each finger as taught by Shieh in order to give the user shortcut functions at their fingertips, and to allow further customization (column 4, line 28-33; column 5, line 10-18).

21.   Regarding claim 14, Lambert does not expressly disclose the use of menus. Shieh discloses that the information processing apparatus which creates a virtual pointing device on a touch screen for executing commands (column 2, line 18-22) further comprises: menu (e.g.

default menu 262, main menu 600) execution level area setting means for setting an area

associated with an execution level of a menu (column 5, line 10-18; column 6, line 7-12); and

menu execution level area designation judging means for judging based on designated

coordinates (initiate display of pull-down menu, select object within menu) whether a set menu

execution level area is designated or not (column 3, line 15-23), wherein when a menu execution

level area is designated and there is a match in fingerprint, the control means executes a menu at

an execution level associated with an authorized user having the matching fingerprint among

execution levels previously set for the respective users (column 4, line 28-42), as well as an

execution level of the designated menu execution level area (column 5, line 30-32). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

provide the use of menus as taught by Shieh in order to allow the added functionality of a

plurality of functions hidden in a drop down menu or the like (column 3, line 15-23).

22.   Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lambert in view of Fitzpatrick or Fernando as applied to claim 1 above, and further in view of

Mori et al. (USPN 5,040,142, cited on applicant's IDS), hereafter Mori.

23.   Regarding claim 15, Lambert does not disclose the processing of a document having a

seal box. Mori discloses that a document having a seal box (window 145) is displayed on the

display means (column 5, line 1-19); and when detected coordinates are coordinates of the seal

box (column 4, line 45-47), the control means affixes an approval seal in the seal box of the

document, the information processing apparatus further comprising: communication means for

communicating an approval-seal affixed document (column 4, line 53-58). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to process a

document having a seal box as taught by Mori in order to securely process shared documents and

allow for approval/review of the documents (column 3, line 49-65).

24.   Regarding claim 16, Lambert does not disclose the processing of a document having a

seal box utilizing approval request processing. Mori discloses that a document having a seal box

is displayed on the display means; and when detected coordinates are coordinates of the seal box,

the control means affixes an approval seal in the seal box of the document (see discussion of

claim 15 above), the information processing apparatus further comprising: approval request

processing means for subjecting an approval-seal affixed document to an approval request

processing (column 3, line 66 to column 4, line 25). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to process a document having a seal

box using approval request processing as taught by Mori in order to securely process shared

documents and allow for the documents to be reviewed/approved by a plurality of users (column

2, line 22-28).

Conclusion

25.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. USPN 5,079,624 to Sasuga et al. discloses a digital image processing apparatus

including a touch screen for entering a password by detecting coordinate positions on the touch

screen. USPN 5,086,385 to Launey et al. discloses an expandable home automation system

including a touch screen keypad for entry of a password or pass code. USPN 6,543,684 to White

et al. discloses a transaction terminal with privacy shield for touch-screen PIN entry.

26.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069.

The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rjh
April 1, 2004

JINGGE WU
PRIMARY EXAMINER